

Am



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/719,276	12/08/2000	Guy De Warrenne Bruce Adams	30990094US	7037

7590 07/08/2004

Paul D Greeley
Ohlandt Greeley Ruggiero & Perle
Suite 903
One Landmark Square
Stamford, CT 06901

EXAMINER

HO, TUAN V

ART UNIT	PAPER NUMBER
----------	--------------

2612

DATE MAILED: 07/08/2004

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/719,276

Applicant(s)

ADAMS ET AL.

Examiner

Tuan V Ho

Art Unit

2612

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1,5-20,24-31 and 33-37 is/are rejected.
- 7) ☒ Claim(s) 2-4,22 and 23 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 08 December 2000 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3, 5, 6.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

Art Unit: 2612

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. The drawings are objected to because legends are required for box elements in Figs. 4 and 5. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect may be deferred until after the examiner has considered the proposed drawing correction. Failure to timely submit the proposed drawing correction will result in the abandonment of the application.

3. Claim 17 is objected to because of the following informalities: the term "claim 15" should be changed to "claim 16" since claim 15 does not recite any printer. Appropriate correction is required.

Art Unit: 2612

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 6, 8, 9, 10, 11, 14, 14, 15, 26, 27, 28, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Tsai (US 5,655,164) cited by Applicants.

With regard to claims 1 and 6, Tsai discloses in Figs. 5 and 9a, a film sound system including data trip recorder 140 and print player 2040, that comprises the system for presentation of the image and related sound (photographic slide or print includes data trip 5 that is used to record sound data, col. 7, lines 29-35), electronic storage device attached to the printed image and adapted to store information defining a passage of sound (data trip 5 is a ROM, WROM, PROM, col. 5, line 23), further adapted to store further information relating to the printed image (recorder unit 140 can be used to edit or modify the photographic print (newly recorded sound data can be used to identify the image in a picture, col. 7, lines 47-67 and col. 8, lines 1-9 and Fig. 8, col. 9, lines 53-64), one device

Art Unit: 2612

connectable to the electronic storage device to enable the information defining the passage to be transferred from the electronic storage device for reproduction and further information (player device 2040 is used to play back sound data recorded in data trip 5, col. 9, line 65-67 and col. 10, lines 1-17; where the recorded sound at the time of photographing the image and further recorded sound data to identify the image in a picture can be played back); and one further device to capture the passage of sound and further information relating to the printed image and to write the information and the further information into the electronic storage device connectable to the electronic storage device (camera 7 including microphone 14 and recorder unit 140 can be used to capture sound data at the time of taking picture and to edit or modify the data so as to have sound data to identify the image in the picture, col. 7, lines 47-67 and col. 8, lines 42-67).

With regard to claim 6, Tsai discloses in Figs. 5 and 9a, a film sound system including data trip recorder 140 and print player 2040, that comprises the further information including a record of camera setting in capture the image provided as the printed image (col. 8, lines 21-41 and lines 58-63; noted that a name of an object such as

Art Unit: 2612

"the Versailles Palace" can be used to locate the location where the image is taken).

With regard to claims 8, 9, 10 and 11, Tsai discloses in Figs. 5 and 9a, a film sound system including data trip recorder 140 and print player 2040, that comprises the further information including descriptors, description of the images and a reference to remotely stored data and remotely store archive (col. 7, lines 57-67; noted that names of locations are used as image descriptors description, reference to remotely stored image data and remotely stored archive).

With regard to claim 13, Tsai discloses the electronic storage device fixedly attached to the printed image (data trip 5 is attached to the printed image as shown in Fig. 8).

With regard to claims 14 and 15, Tsai discloses the sound reproduction device (player 2040 is a part of the film sound system of Tsai, that includes speaker 2045 for sound reproductions, col. 10, lines 12).

With regard to claim 26, Tsai discloses the one of further device being a camera (camera 7 is shown in Fig. 5).

Art Unit: 2612

With regard to claim 27, Tsai discloses the camera used to capture of the passage sound (camera 7 having microphone 14 used to capture sound data is shown in Fig. 5).

With regard to claims 28 and 30, Tsai discloses the camera is used to capture one element of further information (camera 7 having microphone 14 is used to capture a sound passage of a picture when the camera takes the picture; where the element of further information can be **a description of the user** to describe the location such as "The Versailles palace" in addition to the object sound.

With regard to claim 29, Tsai discloses the camera is used to capture one element of further information (camera 7 having microphone 14 is used to capture a sound passage of a picture when the camera takes the picture; where the element of further information can be a description of the user to describe the location such as "The Versailles palace" related to the aspect of the images.

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in

Art Unit: 2612

section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 6, 7, 12, 24 and 25 are rejected under 35

U.S.C. 103(a) as being unpatentable over Tsai.

With regard to claims 6 and 7, Tsai discloses the same subject matter as discussed with respect to claim 1, except that the further information includes location identification related to the location at which the image provided as the printed image was captured and location information obtained from GPS device.

Tsai does not disclose ant GPS device that is used to provide location data of the taken image. However, Official Notice is taken that an electronic camera including a GPS device to provide location data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to implement a GPS device in the camera 7 of Tsai so to obtain location information at the time of taking the picture because the camera including the GPS would allow a user to take a picture where the location information is

Art Unit: 2612

attached to the picture for further identification of the image.

With regard to claim 12, Tsai discloses the same subject matter as discussed with respect to claim 1, except that the further information including security.

Tsai does not explicitly disclose any security information. However, Official Notice is taken for security information is recorded together with an image.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to record a security information related to the image in the data trip 5 of Tsai in order to inform a user about a security protection before erasing or altering the image.

With regard to claim 24 and 25, Tsai does not explicitly disclose any personal computer; however, Official Notice is taken for a personal computer is used to process image and sound data.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the recorder unit of Tsai with a personal computer so as to process sound data and further information because the replacement of the recorder unit of Tsai with a personal computer would allow a user to easily

Art Unit: 2612

to process the data with more accuracy and high speed of the computer.

6. Claims 16, 17, 18, 19, 20, 23, 31, 33 and 35-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai in view of Bell et al (US 5,878,292) cited by Applicants.

With regard to claims 16 and 17, Tsai discloses the same subject matter as discussed with respect to claim 1, except that the further device is printer.

Tsai does not explicitly disclose any printer. However, Bell teaches using an image audio printer 1 that is used to provide audio printed image, col. 5, lines 42-50.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the audio printer of Bell et al in recorder unit of the Tsai system so as to provide a printed image on a hard copy and thereby to easily to distribute and archive.

With regard to claim 18, Tsai discloses the system that includes camera 7 is used to capture the passage of sound directly form the object at the time of

Art Unit: 2612

photographing. Therefore, in the combination of Tsai and Bell et al, the claimed printer adapted to write the information and the further information to the electronic storage device, but not adapted to capture the passage of sound is inherently included because the passage of sound needs to record at the time of taking the picture so as to preserve the true nature of the image.

Claims 19 and 20 recites what was discussed with respect to claims 16-18.

With regard to claim 23, in the combination printer of Tsai and Bell et al, Tsai discloses the recorder unit can record further information by using an input from a user (col. 7, lines 52-60).

Method claim 31 corresponds to apparatus claim 16 and is analyzed the same with respect to apparatus claim 16. Noted that the data trip 5 can be attached to the print at the bottom or on the back as shown in Figs. 8 and 7.

Claim 33 recites what was discussed with respect to claim 1.

Claims 35, 36 and 37 recites what was discussed with respect to claims 14 and 16.

Art Unit: 2612

7. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tsai in view of Bell et al (US 5,878,292).

Tsai in view of Bell et al does not explicitly disclose any fixing of the electronic storage device to the printer image, which occurs before the printing of printed image.

Tsai discloses in another embodiment (Fig. 14) that camera has optical head writer 817 used to place tracks of optical encoded data 25 on to film 200.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the camera system as shown in Figs. 5 and 11 of Tsai so as to obtain an electronic storage device is fixed on the print before writing sound data. That is because attaching the storage device on a print before writing sound data would easily to write sound data for the correct image without any misplace the storage device on other print.

8. Claims 2, 3, 4, 21, 22, 23, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of

Art Unit: 2612

the limitations of the base claim and any intervening claims.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to TUAN HO whose telephone number is (703) 305-4943. The examiner can normally be reached on Mon-Fri from 7AM to 4PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, WENDY GARBER, can be reached on (703) 305-4924. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.



TUAN HO

Primary Examiner

Art Unit 2612